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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,843	04/06/2006	Shinichi Yanagi	288920US0PCT	5093
22850 7590 08/03/2010 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
OLADAPO, TAIWO				
ART UNIT		PAPER NUMBER		
1797				
NOTIFICATION DATE		DELIVERY MODE		
08/03/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/574,843

**Applicant(s)**

YANAGI ET AL.

**Examiner**

TAIWO OLADAPO

**Art Unit**

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1.5-8,11-23 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1.5-8,11-23 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The amendment dated 06/01/2010 has been considered and entered for the record. The amendment overcomes the rejections base on Yamaguchi which are hereby withdrawn. The amendment does not overcome the rejections based on Ryer which are hereby maintained. New rejections are made below.

#### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 5 – 8, 11 – 20, 23, 25, are rejected under 35 U.S.C. 102(b) as being anticipated by Ryer et al. (EP 0 348 236 A2)

4. In regards to claims 1, 6, 11 – 13, 16, 23, 25, Ryer teaches a lubricating oil composition comprising a dispersant additive, wherein the oil can be mineral or synthetic oil (page 14 lines 20, 32), and the dispersant additive is a reaction product of succinimide and phosphosulfurized hydrocarbon prepared by reacting i.e.  $P_2S_5$  and  $\alpha$  or  $\beta$ -pinene which meets the limitations of the claim (abstract, page 13 lines 31 – 40, Example 1). The reaction product of pinene and olefin taught by Ryer is a phospho sulfurized hydrocarbon having two alkyl groups attached to a phosphorus atom and meets the limitation of claim 25 as evidenced by the applicant's specification (Applicant's Specification page 6 lines 5 – 17). Ryer teaches a lubricating oil

composition having the limitations recited in the claims which are suitable for use as automatic transmission fluids (abstract).

5. In regards to claim 5, Ryer teaches the lubricating oil, wherein the phosphosulfurized hydrocarbon is prepared from  $P_2S_5$  and  $\alpha$  or  $\beta$ -pinene as previously stated. Pinene is an olefin having 10 carbon atoms which will produce alkyl groups having the recited amount of carbons.
6. In regards to claims 7, 8, 17 – 20, Ryer teaches the composition used for power transmission fluids etc, which is suitable for lubricating continuously variable transmissions, wet clutches, wet brakes etc (page 14 lines 20 – 28). The viscosity of the base oil ranges from preferably about 3.5 to 5cst at 100°C which meets the limitations in claims 18 – 20.
7. In regards to claims 14, 15, Ryer teaches the composition wherein the lubricating oil comprises the dispersant in the amount of from 0.1 – 7% (page 18, Table 3).

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
11. Claims 21, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryer et al. (EP 0 348 236 A2) in view of Ishida et al. (US 2002/0072478)
12. In regards to claims 21, 22, Ryer teaches the lubricating oil composition comprising mineral or synthetic oils but does not particularly recite the %C<sub>A</sub> of the base oil. Ishida is added to teach automatic transmission fluids similar to Ryer [0002]. Ishida teaches the base oil can be mineral oil having %C<sub>A</sub> of 10% or less which meets the claimed limitations [0024]. It would have been obvious for one of ordinary skill in the art to have used the mineral oils of Ishida as base oils in the invention of Ryer, as they are suitable for use in lubricating transmissions.

#### ***Response to Arguments***

13. The applicants have amended the claims to incorporate limitations requiring that the phospho-sulfurized hydrocarbon compounds are prepared from phosphorus sulfide which overcomes the previous rejections over Yamaguchi. However, the limitation is taught by Ryer, therefore the amendments do not overcome the rejections over Ryer.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAIWO OLADAPO whose telephone number is (571)270-3723. The examiner can normally be reached on 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571)272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TO

/Ellen M McAvoy/  
Primary Examiner, Art Unit 1797